

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Interview of March 10, 2009

The applicants are appreciative of the opportunity to discuss the pending application with the examiner on March 10, 2009. During the interview, the subject matter of the pending claims and U.S. patent nos. 6,334,610 (*Minamishin*) and 5,538,238 (*Filsinger*) were discussed.

In particular, the applicants pointed out that independent claims 1 and 13 require that the first feeding element be movable at least along two axes, a first axis of the axes being parallel to the feeding path and a second axis of the axes being orthogonal to both the feeding path and the insertion direction.

The applicants further pointed out that the feeding element of the *Minamishin* patent is movable only along a single axis. The examiner responded that since the entire machine of the *Minamishin* patent is movable, the feeding element is thus movable along least two axes.

The applicants also pointed out that the rods of the *Filsinger* patent, while movable along two axes, do not move along a second axis that is orthogonal to both the feeding path and the insertion direction. The examiner indicated that since the rods of the *Filsinger* patent can be pulled out and freely moved, they can be moved along a second axis that is orthogonal to both the feeding path and the insertion direction.

2. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claims 1 and 13 are amended to clarify the spatial relationships of how the recited first feeding element is movable along at least two axes. It is respectfully submitted that no new matter is added, since support for the amendments may be found, for example, at least in Figs. 2a through 2d of the pending application and at least in paragraphs [0030], and [0031] of the accompanying description in the specification as originally filed.

Claims 2-12 and 14-24 are left unchanged.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

3. Rejection of claims 1 and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent no. 6,334,610 (*Minamishin*)

Reconsideration of this rejection is respectfully requested, in view of the amendment to claim 1, on the basis that the *Minamishin* patent fails to disclose each and every recited element of amended claim 1. The remaining claim 24 depends from claim 1, and is therefore patentable as containing all of the recited elements of claim 1, as well as for its respective recited features.

By way of review, the embodiment of amended claim 1 requires an apparatus for continuously singling stacks of loose sheet material having a feeding device for moving stacked loose sheet material to be singled along a feeding path from a deposit position to a position where an uppermost sheet can be grasped by a singling unit, and a stack inserting device for moving a stack of loose sheet material to be singled along an insertion direction into the deposit position, wherein a first feeding element is movable at least along two axes relative to the singling unit, wherein a first axis is parallel to the feeding path and a second axis is orthogonal to both the feeding path and the insertion direction, and the first feeding element is movable along the second axis to be inserted into the feeding path.

As is shown in Fig. 2d, in order to provide continuous singling of loose sheet material, the feeding element 2 is moved relative to the singling unit in a direction orthogonal to both the feeding path 8 and the insertion direction, wherein the feeding element 2 is movable along the second axis to be inserted into the feeding path (Figs. 2a, 2b). The feeding element is next moved in a direction parallel to the feeding path 8 and then moved in a direction opposite to the initial movement to a position beneath the combined stack of sheet material.

The *Minamishin* patent discloses a leaf transfer unit to be incorporated into an automatic teller machine (abstract). A partition unit 40, identified on page 3 of the Office action as a first feeding element, is movable only along a single axis in a forward and backward direction with respect to the remaining components of the teller machine (Fig. 4; col. 7, lines 13-18).

This configuration is in contrast to the embodiment of amended claim 1, which requires the first feeding element to be movable at least along two axes relative to the singling unit.

Since the partition unit 40 of the *Minamishin* patent only moves along a single axis with respect to the remaining components of the teller machine, the *Minamishin* patent fails to disclose a first feeding element that is movable at least along two axes relative to the singling unit, as is required by amended claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claim 1 is patentable and therefore, claim 24, which depends from claim 1, is also considered to be patentable as containing all of the elements of claim 1, as well as for its respective recited features.

4. Rejection of claims 1-23 under 35 U.S.C. § 103(a) as being obvious in view of U.S. patent no. 5,538,238 (*Filsinger*)

Reconsideration of this rejection is respectfully requested, in view of the amendments to claims 1 and 13, on the basis that the *Filsinger* patent fails to disclose each and every recited element of amended claims 1 and 13. The remaining claims depend from either claim 1 or 13, and are therefore patentable as containing all of the recited elements of claims 1 or 13, as well as for their respective recited features.

The features of amended claim 1 are discussed above in detail. The features of amended claim 13 are substantially similar to those of amended claim 1 discussed above. In particular, the embodiments of both amended claims 1 and 13 require a first feeding element that is movable at least along two axes relative to the singling unit, wherein a first axis is parallel to the feeding path and a second axis is orthogonal to both the feeding path and the insertion direction, and the first feeding element is movable along the second axis to be inserted into the feeding path.

In contrast the *Filsinger* patent simply does not contemplate the structural arrangement of amended claims 1 and 13 and therefore does not teach every feature of amended claims 1 and 13.

In particular, the *Filsinger* patent does not disclose a first feeding element movable at least along two axes, wherein a first axis is parallel to a feeding path and a second axis is orthogonal to both the feeding path and an insertion direction, and wherein the first feeding element is movable along the second axis to be inserted into the feeding path.

The *Filsinger* patent discloses a sheet feed 1 having a main pile lift 5 including a vertically movable pile table 4, and an auxiliary pile lift 8 (col. 3, lines 58-62). A sheet pile 19 can be disposed on the pile table 4 where a suction head takes the uppermost sheet and delivers it to a printing press (col. 4, lines 5-7; col. 5, lines 42-47).

The *Filsinger* patent is silent with respect to the manner in which the sheet pile is moved to its position on the pile table 4. Therefore, the *Filsinger* patent does not teach a stack inserting device for moving a stack of loose sheet material to be singled along an insertion direction into a deposit position.

As *Filsinger* does not disclose a stack inserting device or a stack inserting direction, *Filsinger* does not disclose a feeding element movable along a second axis which is orthogonal to an insertion direction, as is required by amended claims 1 and 13.

Further, the *Filsinger* patent does not disclose a first feeding element movable at least along two axes, wherein a first axis is parallel to a feeding path and a second axis is orthogonal to both the feeding path and an insertion direction, and wherein the first feeding element is movable along the second axis to be inserted into the feeding path.

In observing Fig. 1, sheets of the sheet pile 19 are clearly moved to the deposit position shown in Fig. 1 from a position outside of the walls 2, 3 and facing the face ends 14, 15. In other words, the sheets are slid in a direction parallel to the lengthwise direction of the rods 22 to the position between the walls 2, 3. Therefore, the insertion direction of the sheets is the direction parallel to a lengthwise direction of the rods 22, as shown in Fig. 1.

Even assuming the insertion direction as discussed above, the *Filsinger* patent still does not disclose a first feeding element movable at least along two axes, wherein a first axis is parallel to a feeding path and a second axis is orthogonal to both the feeding path and an insertion direction.

Pile table 4 of *Filsinger* is movable vertically between walls 2, 3 and has longitudinal indentations 21 for receiving rods 22 (col. 4, lines 6-10). When the height of the sheet pile 19 becomes small, an operator slides the rods into the longitudinal indentations (col. 5, lines 50-52). The auxiliary pile lift 8 is then moved

upwardly so that the rods rest on the rails 10, 16 of the auxiliary pile lift (col. 5, lines 51-55). The main pile table is then moved downwardly to receive a new sheet pile (col. 5, lines 58-61).

On page 3, the Office action relies on the rods 22 as a teaching of the first feeding element. In observing Fig. 1 of the *Filsinger* patent, the rods 22 are moved in a direction parallel to their lengthwise direction so that they are placed in the indentations 21 of the main pile table. The rods are then moved vertically by the auxiliary lift 8. Therefore, the two directions in which the rods move are a first direction parallel to their lengthwise direction and as second direction parallel to the vertical movement of the auxiliary lift 8.

Since the only axes the rods move along are a first axis parallel to their lengthwise direction and a second axis parallel to the vertical movement of the auxiliary lift, the rods do not move along an axis that is orthogonal to both a feeding path and an insertion direction, as is required by amended claims 1 and 13.

Indeed, the rods move along a first axis in their lengthwise direction which is parallel to the insertion direction, not orthogonal to the insertion direction as required by amended claims 1 and 13. The rods also move along a second axis in accordance with the vertical movement of the auxiliary lift which is parallel to the feeding path, not orthogonal to the feeding path as required by amended claims 1 and 13.

In contrast to the *Filsinger* patent the first feeding element of amended claims 1 and 13 is movable at least along two axes, wherein a first axis is parallel to a feeding path and a second axis is orthogonal to both the feeding path and an insertion direction. As such, the *Filsinger* patent does not teach a first feeding element being movable along a second axis that is orthogonal to both the feeding path and an insertion direction as recited in amended claims 1 and 13.

While the rods 22 of the *Filsinger* patent may be removed and moved around in space in a number of different axes (col. 5, lines 64-65), one of which may be

orthogonal to both the feeding path and an insertion direction, the embodiments of amended claims 1 and 13 also require that the first feeding element is movable along the second axis to be inserted into the feeding path.

Since the *Filsinger* patent only discloses a single axis that allows the rods 22 to be inserted into a feeding path, and that axis, as discussed in detail above, is not orthogonal to both the feeding path and an insertion direction, the *Filsinger* patent fails to disclose a first feeding element that is movable at least along two axes relative to the singling unit, wherein a first axis is parallel to the feeding path and a second axis is orthogonal to both the feeding path and the insertion direction, and the first feeding element is movable along the second axis to be inserted into the feeding path, as is required by amended claims 1 and 13.

In summary, *Filsinger* does not teach a stack inserting device and a first feeding element being movable along a second axis that is orthogonal to both the feeding path and an insertion direction, and the first feeding element is movable along the second axis to be inserted into the feeding path. As such, *Filsinger* does not disclose every feature of amended claims 1 and 13.

The Office action provides no secondary teaching of these features of amended claims 1 and 13, and thus, a *prima facie* case of obviousness cannot be established with respect to amended claims 1 and 13, and withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claims 1 and 13 are patentable and therefore, claims 2-12 and 14-24, which depend from either claim 1 or 13, are also considered to be patentable as containing all of the elements of respective claims 1 or 13, as well as for their respective recited features.

5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

BACON & THOMAS, PLLC  
625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314-1176  
Phone: (703) 683-0500  
Facsimile: (703) 683-1080

Date: March 23, 2009

Respectfully submitted,



PATRICK M. BUECHNER  
Attorney for Applicants  
Registration No. 57,504